

## REMARKS

In the Office Action mailed April 16, 2009, claims 153-156, 158-166 and 168-171 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 153-156, 158-166, 167-171 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 153-155, 158-165, and 168-171 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker (U.S. Patent No. 6,227,972) in view of Crouch (U.S. Patent No. 5,580,053).

Claims 156 and 166 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Crouch and further in view of Walker '765 (U.S. Patent No. 6,364,765).

### **35 U.S.C. § 112, first paragraph**

On page 2, the Office Action recites, "Claims 153-156, 158-166, 168-171 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants'specification does not teach the limitation of, "game play enhancements available to the player **only** by way of the promotional award/data".

The Applicants respectfully traverse. The Specification recites at least the following examples in which game play enhancements not otherwise available to a player are made available as a result of use of the promotional award/data:

*"In another embodiment, the enhanced game state invokes at least one additional payline not otherwise available, which may lead to more payouts or to more chances to play a secondary game." (p. 55, ll.8-11)*

*"The next step in enhanced game state embodiments involves invoking an entire game that is not otherwise available. This may be invoked for either the primary game or, if one is*

available, the secondary game. In an embodiment where it is the primary game that changes, using Newprom awards will change the game from one to another, such as a single-hand poker game to a six hand simultaneous play game.” (p. 55, l. 20- p. 56, l.4)

Accordingly, Applicants respectfully submit that the claims as presented in the previous amendment conform to all applicable requirements under 35 U.S.C. §112, first paragraph, and request that the present rejection be withdrawn.

### **35 U.S.C. § 103(a)**

- **Walker (U.S. Patent No. 6,227,972) in view of Crouch (U.S. Patent No. 5,580,053)**
- **Walker in view of Crouch and further in view of Walker ‘765 (U.S. Patent No. 6,364,765).**

Responsive to the rejection of claims 153-155, 158-165, and 168-171 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Crouch and the rejection of claims 156 and 166 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Crouch and further in view of Walker ‘765, Applicants respectfully traverse and request reconsideration of the rejection in light of the following:

The Office Action recites: “However, Walker in view of Crouch fails to teach that the one or more game play enhancements are available to the player only by way of the promotional award. Nevertheless, using only the promotional awards to provide one or more game play enhancements, instead of using promotional awards and wagering money would have been obvious to one of ordinary skilled in the art since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *Ex parte Wu*. See also *In re Larson*, and *In re Kuhle*. For example, omitting the use of wagering money to provide the enhanced game state will leave the remaining element of promotional awards to provide the enhanced game state.” (*Office Action*, p. 5, ll. 5-14)

Applicants respectfully submit that the Office Action mischaracterizes the cited cases with respect to the omission of an element. The MPEP actually cites these cases with respect to the omission of an element and its function *if the function of the element is not desired*” (MPEP § 2144.04,A.)

In the Office Action statement recited above, “omitting the use of wagering money to provide the enhanced game state will leave the remaining element of promotional awards to provide the enhanced game state,” only the element “wagering money” has been removed. The desired function of the wagering money, “to provide the enhanced game state,” has been retained. The MPEP clearly states that “omission of an element with retention of the element’s function is an indicia of *unobviousness*.” (*MPEP § 2144.04, B.*)

Applicants therefore respectfully submit that independent claims 153 and 162 and their respective dependent claims 154-156, 158-161, 163-166 and 168-171 are not obvious in view of the combination of Walker, Crouch and Walker ’765 because these references, alone or in combination, fail to teach or suggest all the claimed limitations of the previously presented claims. Moreover, the dependent claims further recite and define the claimed invention, and thus, are independently patentable. In conclusion, Applicants respectfully submit that the 35 U.S.C. §103(a) rejections of claims 153-156, 158-166 and 168-171 have been overcome.

In view of the foregoing, the Applicants respectfully submit that the application is complete, that claims 153-156, 158-166 and 168-171 are patentably distinct, and request that the application be moved forward for patenting.

Respectfully submitted,

/mhein/

Marvin A. Hein  
Reg. No. 63,376  
Agent for the Applicants  
Bally Technologies  
6601 South Bermuda Road  
Las Vegas, NV 89119  
Direct 702.584.7209